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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte YESHIK SHIN, DAVID D. LEE, and DEOG-KYOON JEONG

Appeal 2008-5290
Application 10/045,625
Technology Center 2600

Decided¹: February 25, 2009

Before JOSEPH F. RUGGIERO, MARC S. HOFF, and ELENI MANTIS-
MERCADER, *Administrative Patent Judges*.

RUGGIERO, *Administrative Patent Judge*.

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 from the Final Rejection of claims 1-24, which are all of the pending claims. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

Appellants' claimed invention relates to a method and device for transmitting synchronization symbols which indicate a type of packet that is to be transmitted after the synchronization symbol (Spec. ¶ [0094], Figure 9A).

Claim 1 is illustrative of the invention and reads as follows:

1. A method for transmitting packet types of packets, the method comprising:
 - receiving a packet having symbols;
 - identifying a packet type of the packet;
 - transmitting a synchronization symbol that corresponds to the identified packet type, wherein the transmitted synchronization symbol provides synchronization information and wherein each packet type has a different synchronization symbol; and
 - transmitting the symbols of the received packet.

The Examiner relies on the following prior art references to show unpatentability:

Burnett	US 5,703,875	Dec. 30, 1997
Deb	US 6,172,990 B1	Jan. 9, 2001
		(filed Nov. 12, 1997)

Claims 9-15 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Burnett.

Claims 1-8 and 16-24 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Burnett in view of Deb.

Rather than reiterate the arguments of Appellants and the Examiner, reference is made to the Brief and Answer for the respective details. Only those arguments actually made by Appellants have been considered in this decision. Arguments which Appellants could have made but chose not to make in the Brief have not been considered and are deemed to be waived [*see* 37 C.F.R. § 41.37(c)(1)(vii)].

ISSUES

- (i) *Under 35 U.S.C. § 102(b), does Burnett have a disclosure which anticipates the invention set forth in claims 9-15?*

The pivotal issue before us in making this determination is whether Appellants have demonstrated that the Examiner erred in determining that Burnett discloses the use of synchronization symbols which indicate the type of message packet to be transmitted.

- (ii) *Under 35 U.S.C. § 103(a), with respect to appealed claims 1-8 and 16-24, would one of ordinary skill in the art at the time of the invention have found it obvious to combine Burnett with Deb to render the claimed invention unpatentable?*

The pivotal issue before us is in making this determination is whether Appellants have demonstrated that the Examiner erred in determining that the combination of Burnett and Deb provides a teaching or suggestion of

using synchronization symbols to indicate the type of message packet that is being transmitted.

FINDINGS OF FACT

The record supports the following findings of fact (FF) by a preponderance of the evidence:

1. Appellants have invented a method and device for transmitting synchronization symbols that include an indication of the type of message packet to be transmitted after the synchronization symbol. A communication node periodically transmits synchronization primitives to enable a receiving node to properly align with the synchronization primitives. Upon receipt of the synchronization primitive, the communication node will know that the primitive is correctly aligned on a symbol boundary. (Spec. ¶¶ [0094]-[0096], Figure 9A).

2. Burnett discloses (col. 2, ll. 39-47) a method for identifying the types of transmitted message packets, such as control messages or data messages, by using “state control words” when, for example, a first switch is about to send a message to a second switch.

3. The “state control word” described by Burnett (col. 2, ll. 47-49, Figure 2) indicates to the receiving second switch into which of the buffers (control message buffer 12 or data message buffer 13) the received message is to be stored.

4. Burnett further discloses (col. 3, ll. 18-21) that the “state control words” can be used to signal the start and end of a message.

5. Deb discloses (col. 21, l. 30 through col. 22, l. 19) a system which is directed to the identifying of a type of received packet and a

transmitted appended index associated with the packet before transmission of the packet.

PRINCIPLES OF LAW

1. ANTICIPATION

It is axiomatic that anticipation of a claim under § 102 can be found if the prior art reference discloses every element of the claim. *See In re King*, 801 F.2d 1324, 1326 (Fed. Cir. 1986) and *Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick Co.*, 730 F.2d 1452, 1457 (Fed. Cir. 1984).

In rejecting claims under 35 U.S.C. § 102, a single prior art reference that discloses, either expressly or inherently, each limitation of a claim invalidates that claim by anticipation. *Perricone v. Medicis Pharmaceutical Corp.*, 432 F.3d 1368, 1375-76 (Fed. Cir. 2005), citing *Minn. Mining & Mfg. Co. v. Johnson & Johnson Orthopaedics, Inc.*, 976 F.2d 1559, 1565 (Fed. Cir. 1992). Anticipation of a patent claim requires a finding that the claim at issue “reads on” a prior art reference. *Atlas Powder Co. v. IRECO, Inc.*, 190 F.3d 1342, 1346 (Fed Cir. 1999) (“In other words, if granting patent protection on the disputed claim would allow the patentee to exclude the public from practicing the prior art, then that claim is anticipated, regardless of whether it also covers subject matter not in the prior art.”) (internal citations omitted).

2. OBVIOUSNESS

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of

obviousness. *See In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). In so doing, the Examiner must make the factual determinations set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 17 (1966). “[T]he examiner bears the initial burden, on review of the prior art or on any other ground, of presenting a *prima facie* case of unpatentability.” *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). Furthermore, “‘there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness’ . . . [H]owever, the analysis need not seek out precise teachings directed to the specific subject matter of the challenged claim, for a court can take account of the inferences and creative steps that a person of ordinary skill in the art would employ.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007)(quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)).

ANALYSIS

35 U.S.C. § 102(b) REJECTION

Appellants’ arguments in response to the Examiner’s anticipation rejection, based on Burnett, of independent claim 9 assert that the Examiner has not shown how each of the claimed features is present in the disclosure of Burnett so as to establish a *prima facie* case of anticipation. Appellants’ arguments (App. Br. 5-6) focus on the contention that, in contrast to the requirements of appealed independent claim 9, Burnett does not disclose the use of any synchronization symbols which correspond to or indicate message packet types.

We agree with Appellants. We do note that the Examiner has correctly determined that the “state control words” in Burnett are used to indicate message packet types, such as control messages or data messages, as do Appellants’ synchronization symbols. We simply do not find, however, any support in the disclosure of Burnett for the Examiner’s finding that Burnett’s “state control words” correspond to the claimed synchronization symbols since there is no indication that such “state control words” in Burnett are used for synchronization of any kind.

As explained and defined by Appellants (Spec. ¶ [0094]), the claimed synchronization symbols permit a receiving node to properly align with the synchronization primitive so that the synchronization primitive, which is made up of a sequence of bit-string synchronization symbols (Spec. ¶¶ [0097-0099] and Tables 3-4), is correctly aligned on a symbol boundary. The “state control words” in Burnett, however, as pointed out by Appellants (App. Br. 6), are primarily used to indicate whether a transmitted message is a control message or data message and to instruct a switch as to which buffer transmitted packets are to be stored (col. 2, ll. 39-49 and col. 3, ll. 18-35).

We recognize that the Examiner, in the responsive arguments portion of the Answer at page 6, further explains the reasoning behind the stated rejection by calling attention to the fact that the type of synchronization performed by the Appellants’ claimed synchronization symbols are not set forth in claim 9. While this is correct, the simple fact remains that the disclosure of Burnett provides no indication, nor has the Examiner provided any valid line of reasoning, to support the contention that any coordination of events that would indicate synchronization of any kind is being performed by the “state control words” in Burnett.

In view of the above discussion, in order for us to sustain the Examiner's rejection, we would need to resort to impermissible speculation or unfounded assumptions or rationales to supply deficiencies in the factual basis of the rejection before us. *In re Warner*, 379 F.2d 1011, 1017 (CCPA 1967). Accordingly, since Appellants' arguments have demonstrated that the Examiner erred in determining that all of the claim limitations are not present in the disclosure of Burnett, we do not sustain the Examiner's 35 U.S.C. § 102(b) rejection of appealed independent claim 9, nor of claims 14-15 dependent thereon.

35 U.S.C. § 103(a) REJECTION

The Examiner's obviousness rejection of independent claims 1 and 16, and their respective dependent claims 2-8 and 16-24, based on the combination of Burnett and Deb is also not sustained. Independent claims 24 and 32 also include the feature set forth in previously discussed independent claim 9 requiring a synchronization symbol that indicates message packet type, but with the further qualifying limitation that packet type identification is based on a received packet.

In addressing the claimed limitations, the Examiner has applied, to Burnett, the teachings of the Deb reference, which is directed (col. 21, l. 30 through col. 22, l. 19) to identifying a type of received packet and a transmitted appended index associated with the packet before transmitting the packet. We find nothing, however, in the disclosure of Deb which overcomes the basic deficiency of Burnett in disclosing the use of a synchronization symbol for identifying the types of transmitted message packets as presently claimed.

CONCLUSION OF LAW

Based on the findings of facts and analysis above, we conclude that Appellants have shown that the Examiner erred in rejecting claims 9-15 for anticipation under 35 U.S.C. § 102(b), and in rejecting claims 1-8 and 16-24 for obviousness under 35 U.S.C. § 103(a).

DECISION

The Examiner's decision rejecting claims 9-15 under 35 U.S.C. § 102(b) and claims 1-8 and 16-24 under 35 U.S.C. § 103(a) is reversed.

REVERSED

gvw

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